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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/721,518

11/25/2003

Koji Yamaya

17280

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23389

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02/13/2008

SCULLY SCOTT MURPHY & PRESSER, PC

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

02/13/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/721,518

**Applicant(s)**

YAMAYA ET AL.

**Examiner**

MATTHEW J. KASZTEJNA

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 6, 7, 9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6, 7, 9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/808)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Notice of Amendment***

In response to the amendment filed on November 29, 2007, amended claims 6-7 and 9-10 and canceled claim 5 are acknowledged. The following reiterated grounds of rejection are set forth.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6-7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,352,503 to Matsui et al. in view of U.S. Patent Application Publication No. 2003/0163029 to Sonnenschein et al.

**In regards to claims 7 and 9-10**, Matsui et al. disclose an endoscope apparatus 101 comprising: an insertion portion 102 having first 141 and second 143 channels arranged therein and terminating at first and second openings, respectively, at a distal portion of the insertion portion; an observation optical system which is arranged to the insertion portion (see Col. 11, Lines 57-59); a first treatment-tool oscillating base which guides, in a first direction, a first treatment-tool 145 guided via the first channel 141 arranged to the insertion portion, the first treatment-tool oscillating base being provided so as to be rotatable in the first opening corresponding to the first channel at a

projection side of the first treatment tool; and a second treatment-tool oscillating base which guides, in a second direction, a second treatment-tool 147 guided via the second channel arranged in the insertion portion, the second treatment-tool oscillating base being provided so as to be rotatable in the second opening corresponding to the second channel at a projection side of the second treatment tool; wherein the end of at least one of the first and second treatment-tools guided by the first and second treatment-tool oscillating bases is guided to the outside of a field of view from the inside of an endoscope image based on an optical image obtained by the observation optical system (see Fig. 29 and Col. 14, Lines 10-67). Matsui et al. are silent with respect to a screen size in the guiding direction of the treatment tool guided to the outside of the field of view from the inside is set to have a shorter side, or to be shorter, as compared with a screen size in the guiding direction of the treatment tool guided within the inside range of the field of view and wherein the screen size has a length in the horizontal direction longer than that in the vertical direction. Sonnenschein et al. teach of an analogous endoscopic apparatus wherein the field of view for the topical channel may be non-circular, such as square, rectangular, cylindrical, toroidal section or any other shape. The views may take on any shape and do not need to be of equal size (see Fig. 3c and paragraph 0075). It would have been obvious to one skilled in the art to vary the field of view with respect to the treatment tools of Matsui et al. to provide adequate visualization and alternate view fields of the tools used with the endoscope as taught by Sonnenschein et al.

**In regards to claim 6**, Matsui et al. disclose an endoscope apparatus, wherein the outside of the field of view is one in the top direction of the screen of the endoscope image (see Figs 1, 12 and 29 and Col. 14, Lines 10-67).

### ***Response to Arguments***

Applicant's arguments filed November 29, 2007 have been fully considered but they are not persuasive.

In response to applicant's argument that Matsui does not teach or suggest that the distal end of one of the treatment tools is guided outside the field of view, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant states that Matsui does not teach or suggest that the distal end of one of the treatment tools is guided outside the field of view. Examiner disagrees. Matsui teaches that the respective forceps raising mechanism raises the insertion section of the treating tool by bending the insertion section of the treating tool outwardly in a direction substantially *perpendicular* to the axial direction of an insertion section 102 of the endoscope 101 (see Col. 14, Lines 18-27). The treatment tool is guided in a perpendicular direction away from the central axis and thus also the field of view of optical system. The further the treatment tool is inserted through the working channel, the further the distal end of the treatment tool will extend perpendicularly away from the

field of view of the optical system. Thus, if the tool is inserted far enough into the body, the distal end of the tool will inherently be moved to outside the field of view.

Furthermore, the word "guidable" in the claim may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use. The distal end of the treatment tool shown in the apparatus of Matsui is fully capable of being guided outside the field of view. Thus as broadly as claimed the combination of Matsui and Sonnenschein et al. meets the limitations of the recited claims.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW J. KASZTEJNA whose telephone number is (571)272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. J. K./  
Examiner, Art Unit 3739

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
Unit 3739

2/11/08